

REMARKS

Claim 1 and the claims dependent thereon have been amended to include the concepts of claims 4 and 5, and claims 4 and 5 canceled. Claim 7 has been amended to depend upon claim 1 and use terminology having proper antecedent support. Claims 1-3 and 6-12 remain active in this application. Such amendments to and cancellation of claims are only for the purpose of expediting the prosecution of this application and are not to be construed as an abandonment of any of the novel concepts disclosed therein.

The office action states:

Claims 1-4, 6, 8-10, and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Bemier US Patent Application Publication 20040040039.

Regarding claim 1, Bemier teaches providing the user of a control device (remote control), an indication of a value (channel number shown in banner 740 in figure 7) currently representative of a preset sound source (channel) and simultaneously providing an indication of a new value of the preset representative of a different sound signal source (the channel numbers shown in Bemier (780) (paragraph 055-056). Bemier teaches further teaches the user is provide with the option of using the remote control to select the new value (channel) (paragraph 045).

Regarding claim 2, Bemier teaches the preset is associated with multimedia system (figure 7).

Regarding claim 3, Bemier teaches the multi-media system comprises an audio system (paragraph 055).

Regarding claim 4, Bemier teaches the indication comprises graphical items such as numbers on the display (figure 7).

Regarding claim 6, Bemier teaches the user confirms the new preset value by selecting a channel number displayed on the screen using the select button (paragraph 45).

Regarding claim 8, Bemier teaches the value comprises an identifier of a station (paragraph 055).

Regarding claim 9, Bemier teaches enabling a user of a remote control to indicate possible new value of a preset sound signal source by displaying a list of channel and highlighting the channel to be added to the list of favorite channel and the channel to be added to the list of favorite channel is confirmed by pressing the add favorite button (paragraph 089). The operation of the second device (TV) is change before confirming the new value of the sound source because the display of the TV is change to indicate the possible new favorite channel (paragraph 088).

Regarding claim 10, Bemier teaches the value comprises an identifier of a station (paragraph 055).

Regarding claim 12, Bemier teaches the sound signal source comprises the movie (item to be performed) to shown (figure 7)

Regarding claim 13, Bemier teaches providing the user of a control device (remote control), an indication of a values of recently invoke presets such as the channel number shown in banner 740 and channel number shown in banner 710 (paragraph 055). The channel number is representative of a sound signal source. .

Regarding claim 14, Bemier teaches selecting a channel listed in area 780 of the display screen and the selected channel changes the operation of the TV by causing the new program selected to be displayed in area 730 of the display (paragraph 056).

Regarding claim 15, Bemier teaches displaying values of possible selection of sound signal sources at one level of a hierarchy values by displaying a list of favorite channel category (figure 16) and enabling a user to select one of the values at the one level of the hierarchy, and while at least a portion of the one level of the hierarchy is displayed (figure 19A), showing possible selections at a second, lower level of the hierarchy that correspond to the one of the values selected by the user, at least another portion of the one level being obscured (paragraph 073-074).

Regarding claim 16, Bemier teaches displaying an identification of the level of the hierarchy (favorite channel categories) currently displayed 9figure 18).

Regarding applicant's argument regarding claims 5, 7, and 11, the reference of Allport teaches downloading TV programming to the remote control to be viewed on the display (col. 7lines 58-67) and the motivation for combining the reference of Bemier and Allport is provided by Allport because Allport teaches displaying information on the remote control in order to avoid affecting the viewing screen of the TV in order to display control information (col. 3 lines 35-38). Pp. 3-5.

This ground of rejection is respectfully traversed. We rely on the authorities set forth on pages 4 and 5 of the Amended Appeal Brief.

The reference does not disclose a display on the control device; therefore, it cannot disclose the claimed method of providing on the display a graphical item that is a representation of an indication of a value currently representative of a preset sound signal source or a graphical item that is an indication of a possible new value of the preset representative of a different sound signal source.

Regarding claim 9, paragraphs 88 and 89 of the reference read as follows:

An example method for scrolling among favorite channels in an IPG screen (also applicable to scrolling among screen presentations of the instances that are favorites) while in the display favorites mode is presented in FIG. 22B. Step 2217 includes receiving a keypress indication associated with scrolling to a favorite channel while in the display favorites mode. In one implementation described above, the user can press the channel up button 483 (FIG. 4) (or 583 of FIG. 5) or the channel down button 486 (FIG. 4) (or 586 of FIG. 5). If the keypress indication indicates it is associated with a channel down keypress (step 2218), a scroll direction to a favorite channel having a lower display channel number than the favorite channel from which the scroll keypress was launched is implemented and the scrolled to favorite channel is highlighted (or tuned to and displayed for presentation screen implementations) in an IPG screen (step 2220). If the keypress indication is associated with a channel up keypress (step 2218), a scroll in the opposite direction is implemented, and the next favorite channel with a higher channel number is highlighted (tuned to and displayed for presentation screen implementations) (step 2222).

Assume the user seeks to add or delete one or more favorite channels using the remote control device 480 (FIG. 4) or 580 (FIG. 5), as illustrated in FIG. 22C. Step 2226 includes receiving a keypress indication associated with either adding to a favorite channel list or deleting from a favorite channel list while in the display favorites mode. Such a keypress indication can be the result of pressing the favorites button 492 (FIG. 4) for a sustained duration, or pressing the add/delete favorites button 594 on the remote control device 580. The user could have highlighted a particular display channel that is or is not a favorite channel (e.g., using the navigation buttons 485 while in the display favorites mode to highlight a non-favorite channel). If the selected channel is not a favorite channel (step 2228), step 2230 includes adding the selected channel to a favorite channel list.

Paragraph 88 discloses scrolling among a list of favorite channels, highlighting a selected one and displaying it. Paragraph 89 discloses adding or deleting favorite channels. When adding a selected channel that is not currently a favorite channel to the favorite channel list, there is not one mention in paragraph 89 about first tuning to such selected channel so the user can view the channel content to confirm that it should be added to the favorite list. It is improper for the Examiner to pick and choose isolated elements from the reference in paragraph 88 which relates to scrolling among favorites, and adding it to paragraph 89, which relates to the different topic of adding and deleting favorites.

The alleged teaching is found, not in the references but in the claims being rejected. It is error to reconstruct the claimed invention from the prior art by using the rejected claim as a "blueprint." *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 548 (Fed. Cir. 1985).

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. 15 This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." 16 *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

Manifestly, since the reference fails to anticipate claim 9, it does not anticipate claims 10 and 11.

Accordingly, withdrawal of the rejection of claims 1-3, 6, 8-10 and 12 is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to each limitation in at least claims 1 and 9.

The office action states:

Claims 5, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bemier US Patent Application Publication 20040040039 in view of Allport US Patent 6104334.

Regarding claim 5, Bemier teaches the display is provided by the television (figure 7) and is silent on teaching the display is part of the control device. Allport in an art invention in the same field of endeavor of remote control teaches the control device (10) providing a displaying current preset of a sound source (col. 5 lines 5 -49, col. 5 lines 59-65, col. 7 lines 58-67) and shown in figure 5.

It would have been obvious to one of ordinary skill in the art to modify the remote control system of Bemier as disclosed by Allport because this allows the remote control functions without directly interfacing with the television screen and further extending the reach of the remote control.

Regarding claim 7, Bemier teaches the control device communicate with the television (second device) to effect the new preset value (paragraph 061).

Regarding claim 11, Bemier teaches an audio sound source (paragraph 055) but is silent on teaching the station comprises a radio station and another device comprises a radio receiver.

Allport in an art invention in the same field of endeavor of remote control teaches the sound source is a radio broadcast (col. 27 lines 1-15) and a radio receiver is inherently used to reproduce the broadcast sound from a radio station.

It would have been obvious to one of ordinary skill in the art to modify the remote control system of Bemier as disclosed by Allport because a radio station is a sound source use to broadcast audio signal to a radio receiver. Pp. 6-7.

This ground of rejection is respectfully traversed. We have shown above that the primary reference does not anticipate claims 1 or 9; therefore, it is impossible to combine the primary and secondary references to meet the limitations of claims 7 and 10.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

That it is impossible to combine the references to meet the limitations of the rejected claims is reason enough for withdrawing the rejection of them. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the references regarded as corresponding to each limitation in these rejected claims.

In view of the foregoing amendments, cancellations, authorities, remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, he is respectfully requested to telephone the undersigned attorney at 617-521-7014 to discuss what additional steps he believes are necessary to place the application in a condition for allowance.

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Entry of this amendment is respectfully requested to place the application in a condition for allowance, or at least in a better form for appeal.

Please apply any charges or credits to deposit account 06-1050, order 02103-581001.

Respectfully submitted,
FISH & RICHARDSON, P.C.

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Date: _____

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